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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,325	12/31/2001	Saori Kitao	04276.00003	2310
22907	7590	04/06/2005		EXAMINER
BANNER & WITCOFF				YAEN, CHRISTOPHER H
1001 G STREET N W				
SUITE 1100			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20001				1642

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/889,325	KITAO ET AL.
	Examiner	Art Unit
	Christopher H. Yaen	1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 November 2004.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
  - 4a) Of the above claim(s) 1-6 and 8-14 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 7 is/are rejected.
- 7) Claim(s) 15 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. <u>3282005</u> .                                     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input checked="" type="checkbox"/> Other: <u>Exhibit A</u> .            |

## DETAILED ACTION

**Re: Kitao et al**  
**Priority Date: 19 January 1999**

1. The amendment filed 11/17/2004 is acknowledged and entered into the record. Accordingly, claim 15 is newly added.
2. Claims 1-15 are pending, claims 1-6 and 8-14 are withdrawn as being drawn to a non-elected invention.
3. Claims 7 and 15 examined on the merits.

## NEW ARGUMENTS

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Fu et al (US Patent 6,090,620). Claim 7 is drawn to a diagnostic agent which contains an antibody which is capable of binding to RecQ4 helicase as shown in SEQ ID No: 4. Fu et al teaches an antibody that is “capable” of binding to SEQ ID No: 4 (see exhibit A and col. 3, lines 8-17, for example). Because it is well known in the art that the minimum requirement for an antibody epitope is 6 contiguous amino acids (evidenced by Harlow

*Antibodies: A laboratory Manual*, 1998; Chapter 5 page 76), in the absence of evidence to the contrary the antibody taught by Fu et al would be "capable" of binding to RecQ4 as claimed. Moreover, the office does not have the facilities and resources to provide the factual evidence needed in order to establish that the product of the prior art does not possess the same material, structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is on the applicant to prove that the claimed product is different from those taught by the prior art and to establish patentable differences. See *In re Best* 562F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte Gray* 10 USPQ 2d 1922 (PTO Bd. Pat. App. & Int. 1989).

**All other rejections are withdrawn in view of the applicant's amendments and arguments thereto as set forth in a paper filed 11/17/2004.**

### **Conclusion**

No claim is allowed.

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1642

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H. Yaen whose telephone number is 571-272-0838. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Yaen  
Art Unit 1642  
March 28,2005

*Jeffrey*  
JEFFREY SIEW  
SUPERVISORY PATENT EXAMINER  
*3/29/05*

RESULT 5  
 US-08-781-891-75  
 Sequence 75, Application US/08781891  
 Patent No. 6096620  
 GENERAL INFORMATION:  
 APPLICANT: Fu, Ying-hui  
 APPLICANT: Yu, Chang-junko  
 APPLICANT: Mulligan, John T.  
 APPLICANT: Schellenberg, Gerald D.  
 TITLE OF INVENTION: GENE AND GENE PRODUCTS RELATED TO  
 TITLE OF INVENTION: WERNER'S SYNDROME  
 NUMBER OF SEQUENCES: 209  
 CORRESPONDENCE ADDRESS:  
 ADDRESSEE: SEED and BERRY LLP  
 STREET: 6300 Columbia Center, 701 Fifth Avenue  
 CITY: Seattle  
 STATE: Washington  
 COUNTRY: USA  
 ZIP: 98104-7092  
 COMPUTER READABLE FORM:  
 COMPUTER: IBM PC compatible  
 OPERATING SYSTEM: PC-DOS/MS-DOS  
 CURRENT APPLICATION DATA:  
 APPLICATION NUMBER: US/08/781,891  
 REFERENCE/DOCKET NUMBER: 240052.419  
 FILING DATE: 27-DEC-1996  
 CLASSIFICATION: 800  
 ATTORNEY/AGENT INFORMATION:  
 NAME: No. 6096620tenburg Ph.D., Carol  
 REGISTRATION NUMBER: 39,317  
 TELECOMMUNICATION INFORMATION:  
 TELEPHONE: (206) 622-4900  
 TELEFAX: (206) 682-0311  
 INFORMATION FOR SEQ ID NO: 75:  
 SEQUENCE CHARACTERISTICS:  
 LENGTH: 607 amino acids  
 TYPE: amino acid  
 STRANDEDNESS: single  
 TOPOLOGY: linear  
 US-08-781-891-75

Query Match 9.8%; Score 632.5; DB 3; Length 607;  
 Best Local Similarity 37.6%; Pred. No. 1.6e-42; Gaps 15;  
 Matches 164; Conservative 63; Mismatches 134; Indels 75;

Qy 771 TVAFGMGLDRPDVRAVTLHGLGLPPSFESYVQAVGRAGRDGQPAHCNHLFLQPGEDLRLR 830  
 Db 301 TVAFGMGLDRPDVRAVTLHGLGLPPSFESYVQAVGRAGRDGQPAHCNHLFLQPGEDLRLR 360  
 Qy 831 H 831  
 Db 361 H 361

RESULT 6  
 US-09-618-166-75  
 Sequence 618, Application US/09166751  
 Patent No. 6181667  
 GENERAL INFORMATION:  
 APPLICANT: ICDPPIKQYDGSDAQ 416  
 APPLICANT: ADMAWLRCLLAKPOQ-LDIERHKLNMAGAFABAQTCCRLLVLUVNYFGSGRQBPGCNCI 400  
 Db 342 ADMAWLRCLLAKPOQ-LDIERHKLNMAGAFABAQTCCRLLVLUVNYFGSGRQBPGCNCI 400

Qy 856 TCTTRPSEBQEGAVGE 871  
 Db 401 ICDPPIKQYDGSDAQ 416